

Supreme Court of the United States

OCTOBER TERM 1945

No.

ALBA TRADING CO. INC.,

Petitioner
(Defendant below).

against

MUSHER FOUNDATION, INC.,

Respondent
(Plaintiff below).

**BRIEF IN SUPPORT OF PETITION FOR WRIT
OF CERTIORARI**

Argument

The Circuit Court of Appeals sustained Patent No. 2,221,404 granted to respondent on November 12, 1940. The patent has only two claims, one for process, the other for product.

The process claim reads:

"1. The method of treating a glyceride oil to give it novel flavor and odor characteristics which comprises infusing said oil at a slightly elevated temperature with a small amount of a low moisture

containing, dehydrated, macerated olive paste for a short period and then removing the olive paste solids therefrom." (Record, p. 148.)

The product claim reads:

"2. A substantially stabilized glyceride oil having novel flavor and odor characteristics containing a small amount of the glyceride oil soluble constituents derived from a dehydrated, low moisture containing, macerated olive paste, the oil being substantially free of the fibers of said olive paste." (Record, p. 148).

The District Court dismissed the process claim as not infringed (Record p. 160) because petitioner does not use heat (Record p. 159). (Opinion of Circuit Court of Appeals, Record p. 172, fol. 173).

The District Court dismissed the product claim because it did not comply with Section 4888 of Revised Statutes (35 U. S. C. § 33) (Record p. 161).

POINT I

Process claim.

To sustain a charge of infringement of Claim One, the Circuit Court asserts that time and temperature are correlative factors (Record p. 173, fol. 173). The Circuit Court states that "a slightly elevated temperature" and a "short period" are equivalent to "a reduced temperature" and "longer time" (Record p. 173, fol. 174). Temperature and time being correlative factors (Record p. 172, fol. 173), how then can there be equivalency where the factors involved are each indefinite as to their value? To determine the value of the factors "slightly elevated temperature" and "a short period" used in the claim it is necessary to refer to the body of the specification of the patent (Record p. 148, line 6, column 2) where it is

defined as 175° F. and 15 minutes respectively. The value of the factors "reduced temperature" and "longer time" are given in the record (Record p. 173, fol. 173) as room temperature and three days the equivalent of which are 68° F. and 72 hours or 4320 minutes.

Can it be said from the above that the respondent's pair of factors or their product (175 x 15) is equivalent to the petitioner's pair of factors or their product (68 x 72 x 60) respectively? To determine the amount of heat required to process either the respondent's or the petitioner's product many additional factors are needed and are not to be found either in the patent or in the proof submitted. To attempt it is to speculate.

Further, this assertion of equivalency by the Circuit Court presupposes the heating of identical masses as to composition and quantity. But the Circuit Court acknowledges (Record p. 174, fol. 176) that the masses are not identical in composition, for the petitioner uses in the food oil an unsalted olive mass, whereas the patentee uses in the food oil a salted olive mass. It is evident that the quantities of heat in such cases are not identical, particularly where the quantities so heated must of necessity be large in order to manufacture the product.

The Circuit Court of Appeals in discussing the process claim said:

"When this process (petitioner's) is compared with that described in Claim One, two differences, and only two, appear: the process is carried on at room temperature and not for a short time." (Record p. 172, fol. 173).

In this the Circuit Court overlooks another important difference, for the petitioner "does not salt the olives out of which it makes its paste," as the Circuit Court itself points out in its opinion (Record p. 174, fol. 176), while the respondent uses salted paste.

The Circuit Court states in its opinion that the Claim should be read with reference to the specification, but disregards that rule entirely by failing to read into Claim One that the olive paste mentioned therein, as described in the specification, must be salted. (Record p. 147, line 60, column 1, page 147, and lines following in column 2; also lines 23 to 30, column 2 of same page; also lines 43 to 45 in same column).

The patentee states in his patent that unsalted olives are incapable of treatment in accordance with his invention (Record p. 148, lines 21 to 30, column 2). That in itself would negative the statement of the Circuit Court that the petitioner's process is equivalent to the process described in the patent. But this assertion of equivalency still leaves the terms of the Claim One in the use of the terms "at a slightly elevated temperature" and "for a short period" too indefinite to make it good under decisions of this Court.

United Carbon Co. v. Binney & Smith Co., 317 U. S. 228 (1942);

General Electric Co. v. Wabash Corp., 304 U. S. 364 (1937).

In *United Carbon Co. v. Binney & Smith Co.*, *supra*, the Court said, at page 232:

"Section 4888 of the Revised Statutes, 35 U. S. C. Sec. 33, requires that the applicant for a patent 'shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' As the Court recently stated in *General Electric Co. v. Wabash Corp.*, 304 U. S. 364, 369:

" 'Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protec-

tion of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' The claims 'measure the invention' * * * In a limited field the variant must be clearly defined.' "

and at page 234:

"Respondent urges that the claims must be read in the light of the patent specification, and that as so read they are sufficiently definite. Assuming the propriety of this method of construction, cf. *General Electric Co. v. Wabash Corp.*, *supra*, at 373-375, it does not have the effect claimed, for the description in the specification is itself almost entirely in terms of function."

and concluded at page 236:

"The statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field. Moreover, the claims must be reasonably clear-cut to enable courts to determine whether novelty and invention are genuine."

How can one find from the reading of Claim One, what *temperature* is meant by "a slightly elevated temperature" and what is "for a short period" (as to time)? Both are indefinite.

The respondent in this case is confronted with another objection to the decision of the Circuit Court, for prior to the granting of the patent the respondent voluntarily cancelled therefrom three claims which did not contain the element of heat in the process (Record p. 166, Opinion of CC of A. (Record p. 173, fol. 174). Because of that the petitioner maintained that the respondent was estopped to claim any equivalents (Record p. 173, fol. 174).

The Circuit Court met this argument by holding that only when an examiner rejects a claim and the inventor then withdraws it, does the disclosure *pro tanto* pass into the public domain, thereby estopping the inventor from resorting to the doctrine of equivalents. But when the withdrawal is made by the inventor voluntarily, the rule is otherwise, the Court said. (Record p. 174, fol. 175). This is a departure from well-settled principles as decided more than once by this Court.

Schreiber Co. v. Cleveland Trust Co., 311 U. S. 211, 220 (1940);

Leggett v. Avery, 101 U. S. 256, 259 (1879).

In the case of *Schreiber Co. v. Cleveland Trust Co.*, above cited, Mr. Justice Stone said at page 220:

"It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. *Shepard v. Carri-gan*, 116 U. S. 593; *Sutter v. Robinson*, 119 U. S. 530; *Roemer v. Peddie*, 132 U. S. 313; *Phoenix Caster Co. v. Spiegel*, 133 U. S. 360; *Hubbell v. United States*, 179 U. S. 77; *Weber Electric Co. v. E. H. Freeman Electric Co.*, 256 U. S. 668; *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, 443. The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had

without the amendments, the cancellation of which amounts to a disclaimer. *Smith v. Magic City Club*, 282 U. S. 784, 790; *Weber Electric Co. v. E. H. Freeman Electric Co.*, *supra*, 677, 678; *I. T. S. Rubber Co. v. Essex Rubber Co.*, *supra*, 444. The injurious consequences to the public and to the inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. See *Leggett v. Avery*, 101 U. S. 256, 259."

As this Court said in the above case, "the cancellation of a claim amounts to a disclaimer."

A disclaimer has the same consequences whether made voluntarily or by compulsion.

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477 (1935).

In the above case this Court, speaking through Mr. Justice Stone, stated, at page 492:

"* * * The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim or hold by virtue of the patent.' Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public."

Walker on Patents (Deller's Edition), vol. 1, p. 336, says:

"And where an inventor cancels from an application, a claim for a particular invention, and substitutes

no other claims for the same invention, before the patent is issued, he will be held to abandon the particular invention." (Citing cases.)

The rule laid down by the Circuit Court in the case at bar is in direct contradiction to the decision of the Circuit Court of Appeals for the Fifth Circuit in

Dry Hand Mop Co. Inc. v. Squeez-Ezy Mop Co. Inc., 17 Fed. (2d) 465 (1927),

where the Court said, at p. 466:

"The voluntary relinquishment of the element gives the public the right to use it in substitution as against any claim of equivalency."

The Circuit Court seems to imply that the burden of proof was on the petitioner and not on the respondent to show why the three claims were cancelled, when it says:

"Certainly no such intent was proven here" (Opinion, Record p. 174, fol. 175).

The Court then says:

"We shall dispose of the case on the assumption that the reason does not appear, for the record is silent" (Opinion, Record p. 174, fol. 175).

Immediately thereafter the Court enters the realm of conjecture to determine why the patentee abandoned the claims, and says:

"Be that as it may, there is a conclusive reason in this case which would put Claim One outside the exception, even if it had been shown that the applicant had actually intended to surrender the contents of the cancelled claims. All of them contained as an element that the paste or the olives must be salted; and the defendant does not salt the olives out of which it makes its paste. The applicant may well

have cancelled the three claims in question precisely, because they did not include that 'much less preferable' alternative, which he had disclosed and claimed. We therefore hold Claim One entitled to the same range of equivalents as though the three claims had not been cancelled; and that, when the defendant lengthened the time and reduced the temperature, it adopted the equivalent of a 'short' time and a 'slightly elevated temperature'."

All this without a word about it in the record, as the Court itself concedes (Record p. 174, fol. 175).

In making this assumption the Circuit Court proves conclusively that petitioner did not infringe, as the Circuit Court states that the difference between the claims cancelled and those retained by the inventor is the mention of salted olive paste in the cancelled claims (Opinion, Record p. 174, fol. 176). But, as we have shown, the respondent is using salted olive paste, for that is the only thing specified in the patent. In fact the patentee states that unsalted olives "are not capable of treatment in accordance with this invention" (Record p. 148, lines 21 to 23, column 2). Therefore, he has cancelled the process he described, and retained a claim of a process that he does not disclose in his patent.

Lastly, if we are to read the claim upon specification, as the Circuit Court says we must, it becomes apparent that the patent in question was granted for an infusion process of specially prepared olives as described in said specification (Record p. 147), while the olives used by petitioner are ordinary olives sold in the open market, which were known to the trade long before the patent in question (Record p. 120, fol. 358); furthermore the olive paste used by the petitioner is not salted, while the one used by the respondent is salted (Record p. 174, fol. 176).

POINT II

Product claim.

The product claim is invalid on its face.

Revised Statutes, Sect. 4888, 35 U. S. C. § 33;
Holland Furniture Co. v. Perkins Glue Co., 277
U. S. 245 (1927);
General Electric Co. v. Wabash Appliance Co.,
304 U. S. 364 (1937);
United Carbon Co. v. Binney & Smith Co., 317
U. S. 228 (1942).

This Court speaking through Mr. Justice Stone said in *Hollander Furniture Co. v. Perkins Glue Co.*, *supra*, at page 257:

“Revised Stat. Sect. 4888, requires that patent shall contain a description of the invention ‘and of the manner and process of making, constructing, compounding, and using it in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same.’ One attempting to use or avoid the use of Perkins’ discovery as so claimed and described functionally could do so only after elaborate experimentation. Respondents say that laboratory tests would be insufficient and that ‘the best and probably the only satisfactory test is to try it out on a large scale in a furniture or veneering gluing factory.’ A claim so broad, if allowed, would operate to enable the inventor who has discovered that a defined type of starch answers the required purpose to exclude others from all other types of starch and so foreclose efforts to discover other and better types. The patent monopoly would thus be extended beyond the discovery and would discourage rather than promote invention.”

And again speaking through Mr. Justice Read in the case of *General Electric Co. v. Wabash Appliance, supra*, this Court said at page 368:

"We need not inquire whether Pacz exhibited invention, or whether his product was anticipated. The claim is invalid on its face. It fails to make a disclosure sufficiently definite to satisfy the requirements of R. S. § 4888, 35 U. S. C. § 33. That section requires that an applicant for a patent file a written description of his discovery or invention 'in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains * * * to make, construct, compound and use the same; * * * and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' "

And further at page 372:

"But Congress requires for the protection of the public, that the inventor set out a definite limitation of his patent; that condition must be satisfied before the monopoly is granted. The difficulty of making adequate description may have some bearing on the sufficiency of the description attempted, but it cannot justify a claim describing nothing new except perhaps in functional terms. *It may be doubted whether one who discovers or invents a product he knows to be new will ever find it impossible to describe some aspect of its novelty.*" (Italics ours.)

concluding at page 373 with:

"The product claims here involved cannot be validated by reference to the specification. Assuming that in a proper case a claim may be upheld by reference to the descriptive part of the specification in order to give definite content to elements stated in the claim in broad or functional terms, the specification of the Pacz patent does not attempt in any way to describe the filament, except by mention of its coarse-grained quality. Even assuming that definite-

ness may be imparted to the product claim by that part of the specification which purportedly details only a method of making the product, the description of the Pacz process is likewise silent as to the nature of the filament product. Although in some instances a claim may validly describe a new product with some reference to the method of production, a patentee who does not distinguish his product from what is old except by reference, express or constructive, to the process by which he produced it, cannot secure a monopoly on the product by whatever means produced. 'Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent, which is not made by that process.'

"Finally, the product claims may not be saved by a limitation to products produced in accordance with the process set out in the specification. This construction, though possibly of no avail against respondent, might add to the protection afforded petitioner by the process claims, if they are valid, in view of its application to filaments produced abroad. But putting aside questions as to the general propriety of such a construction, unless the claim uses language explicitly referring to the method of preparation, or describing the product in phrases suggestive of that process, to save the product claim in this fashion would constitute an improper importation into the claim of a factor nowhere described there. The claims in suit seek to monopolize the product however created, and may not be reworded, in an effort to establish their validity, to cover only the products of the process described in the specification, or its equivalent."

See also the language of this Court speaking through Mr. Justice Jackson, appearing on pages 11 and 12 of this brief.

The Circuit Court of Appeals for the Fifth Circuit considering a patent affecting dyeing fruit in the case of *Fruit Treating Corporation, et al. v. Food Machinery*

Corp., 112 Fed. (2d) 119 (1940), cert. denied 311 U. S. 679, said at page 121:

"When a patent is claimed for discovery, the law requires the patentee to state its component parts with clearness and precision, and to give a practical statement of its ingredients. When this burden is not met, or is met only vaguely and ambiguously, and it is apparent on the face of the specifications that no one could use the invention without first ascertaining by experiment the exact proportions of the different ingredients required to produce the result desired, it is the duty of the Court to declare the patent void. In this case, the temperature variations, the shade or concentration of color desired, and the wide choice of ingredients, with their different powers and qualities, require a formula changing according to conditions. It is hardly conceivable that anyone, however skilled in the art, could obtain satisfactory results when dyeing oranges by the process patented without repeated experiments. Moreover, if from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent. *Wood v. Underhill*, 5 How. 1, 12 L. Ed. 23.

"The patentee, obviously in an effort to make his claims and specifications so all-inclusive that any process for the dyeing of oranges that might be devised would necessarily infringe his patent, not only has made them too broad to be included in the scope of the monopoly given by the patent laws, but he has failed sufficiently to particularize a definite formula or process, complete with ingredients and the proportions of their mixture, which is essential to a valid patent. Since each of the three claims in question depend for its validity upon the sufficiency of the disclosures of the patent, the defect mentioned is the spoliation of all, and the bill of complaint should have been dismissed."

The decision of the Circuit Court in the case at bar is contrary to its own decision in the case of *B. B. Chemical*

Co. v. Cataract Chemical Co., 122 Fed. (2d) 526 (1941), where the Court said at page 529:

"But it was not enough to avoid dedicating his invention to the public to teach those skilled in the art how to practice it; he was required to state clearly what he claimed to be new in his invention. *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, 58 S. Ct. 899. 82 L. Ed. 1402. To secure a good patent, he had to secure valid claims for they are the measure of the grant to a patentee. *Smith v. Snow*, 294 U. S. 1, 55 S. Ct. 279, 79 L. Ed. 721. All the claims in suit were held valid below because it was found that they did sufficiently define what he claimed.

"We are, however, unable to agree. The viscosity of the softener of claims 1, 20 and 21 is whatever will cause it to remain, when not under pressure, substantially where placed on dried pyroxylin cement and that of claim 2 is merely 'high'. Despite the fact that viscosity could be measured and stated accurately in terms of known definite symbols, Wedger described it merely in terms of what the desired viscosity would cause the softener to do. That is insufficient since it would create an unlawful extension of coverage by permitting a patentee to adopt the expedient of describing his product in the terms of function. *Holland Furniture Co. v. Perkins Glue Co.*, 277 U. S. 245, 48 S. Ct. 474, 72 L. Ed. 868. As was said in *General Electric Co. v. Wabash Appliance Corp.*, *supra* (304 U. S. 364, 58 S. Ct. 903, 82 L. Ed. 1402), 'The difficulty of making adequate description may have some bearing on the sufficiency of the description attempted, but it cannot justify a claim describing nothing new except perhaps in functional terms.' And unless the word 'high' has an accepted meaning in the art or is defined in the specifications, claim 2 is left too vague to be valid. Moreover, claims 1, 19, 20 and 21 also are tied to the term 'high viscosity nitrocellulose' or 'high viscosity cellulose derivative.' The Trial Court found on somewhat disputed, but clearly sufficient, evidence that the art knew no definite meaning for the expression 'high

viscosity' as applied to nitrocellulose. We must, therefore, turn to the specifications to find whether Wedger there defined these expressions used in his claims.

"The importance of this flows from the statutory requirement of R. S. Sec. 4888, 35 U. S. C. A. Sec. 33, that a patent application must not only so describe the invention or discovery that one skilled in the art may learn how to practice it but 'shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.' And this has been emphasized within the last few years in *General Electric Co. v. Wabash Appliance Corp.*, *supra*, as follows: 'Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. * * * The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' "

A claim for a product must define a substance which is different from previously existing substances.

The product claim to be new must be defined, not by the way the product is made, but by certain characteristics which will distinguish it from pre-existing similar products, for example, by color test, precipitation test or any other reaction, whether physical, chemical or mathematical.

The product claim in the patent in issue does not define the quantity or proportion of olive oil infused into the corn oil as one to the other.

"A small amount" is not a definite ratio and therefore the resulting product as described in the claim will make

any mixture, whether infused or otherwise, of corn oil and olive oil to be an infringement.

The term, "low moisture containing," is again an indefinite statement giving no information of how much or in what ratio is the moisture reduced from its original contents. All oils manufactured previously to issue of this patent, particularly corn oil containing olive oil, were free of fibers of olive fruit.

"Having a novel flavor" does not define with what other flavor it is comparable or in what way it differs from corn oil containing olive oil that was in existence previous to the issue of this patent.

It is axiomatic that the description of the invention cannot be used to enlarge the scope of a claim. The claim is the statement of the invention and of its scope—not the description.

But let us assume that the claim is good. It still does not anticipate the product of the petitioner, for the petitioner uses unsalted olives (Record p. 174, fol. 176).

The patentee states that unsalted olives are incapable of treatment in accordance with his invention:

"The high moisture containing olive in its original and natural condition is not capable of treatment in accordance with this invention. Where the original undried olive is ground to a paste and where that paste is then added to and mixed in the glyceride oil, said glyceride oil does not take on the desirable flavor and aromatic and other characteristics which are obtained when the olive is first processed in the manner indicated above and then ground in the glyceride oil" (Record, p. 148, lines 21 to 30, column 2).

In view of the above, we respectfully submit that the product claim is invalid, but if valid it certainly is not infringed.

Conclusion

The questions above adjudicated by the Circuit Court of Appeals are of great importance to the administration of the patent laws and of great public interest. The petition for a writ of certiorari should be granted.

Respectfully submitted,

JOSEPH JOFFE,
Counsel.

New York, October, 1945.